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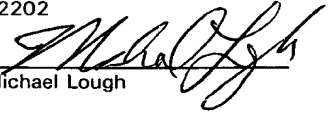
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Applicant: Banerjee *et al.*
Serial No.: 09/887,281
Conf. No.: 6268
Filed: June 22, 2001
For: **BRONCHODILATING COMPOSITIONS AND METHODS**
Art Unit: 1614
Examiner: Weddington, K.

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Michael Lough

#18

PETITION PURSUANT TO 37 C.F.R. §1.181

Commissioner for Patents
U.S. Patent and Trademark Office
P.O. Box 2327
Arlington, VA 22202

Dear Sir:

Applicant hereby submits a Petition pursuant to 37 C.F.R. §1.181 for reconsideration and removal of the finality of the Office Action, mailed January 22, 2003, in connection with the above-captioned application. This Petition is being filed within two months of the mailing of the final rejection.

It is respectfully submitted that the Office Action, mailed January 22, 2003 (hereinafter the Office Action), which was made final, introduces new grounds of rejection that are not necessitated by amendment, and therefore should not have been made Final.

In the Office Action, claims 71-73 are rejected under 35 U.S.C. §112, first paragraph, for alleged lack of enablement. Claims 1, 4-12, 18-21, 27-29, 35-38, 44-49, 54, 57-61, 77-79, 88, 89 and 94-99 are rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Hochrainer *et al.* (U.S. Patent No. 6,150,418). Claims 13-17, 22-26, 30-34, 39-43, 50-53, 55, 56, 58, 65-67, 71-73, 80-87, 92,



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93 and 97-99 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Hochrainer *et al.*

The rejection under 35 U.S.C. §112, first paragraph, is made for this first time in the Office Action. Hochrainer *et al.* is cited for the first time in the Office Action.

It is stated in the Office Action that Applicant's amendment necessitated the new grounds of rejection. Applicant respectfully traverses this finding for the following reasons.

The instant Office Action is the second action on the merits in this application. The first Office Action on the merits was mailed May 22, 2002. In a response mailed August 22, 2002, Applicant amended only claim 8 to correct an obvious typographical error as follows:

8. (Amended) The pharmaceutical composition of claim 7, wherein the tonicity adjusting agent is ammonium carbonate, ammonium chloride, ammonium lactate, ammonium nitrate, ammonium phosphate, ammonium sulfate, ascorbic acid, bismuth sodium tartrate, boric acid, calcium chloride, calcium disodium edetate, calcium gluconate, calcium lactate, citric acid, dextrose, diethanolamine, dimethylsulfoxide, edetate disodium, edetate trisodium monohydrate, fluorescein sodium, fructose, galactose, glycerin, lactic acid, lactose, magnesium chloride, magnesium sulfate, mannitol, polyethylene glycol, potassium acetate, potassium chlorate, potassium chloride, potassium iodide, potassium nitrate, potassium phosphate, potassium sulfate, [propylene] propylene glycol, silver nitrate, sodium acetate, sodium bicarbonate, sodium biphosphate, sodium bisulfite, sodium borate, sodium bromide, sodium cacodylate, sodium carbonate, sodium chloride, sodium citrate, sodium iodide, sodium lactate, sodium metabisulfite, sodium nitrate, sodium nitrite, sodium phosphate, sodium propionate, sodium succinate, sodium sulfate, sodium sulfite, sodium tartrate, sodium thiosulfate, sorbitol, sucrose, tartaric acid, triethanolamine, urea, urethan, uridine or zinc sulfate.

No other claims were amended and no new claims were added.

Accordingly, it is respectfully submitted that the amendments of the claims do not necessitate the new grounds of rejection. To the extent that the amended claims could be rejected over the new reference and on the new grounds, the

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original claims could have been so-rejected, since the claims prior to the first Office Action on the merits and the claims as amended in response thereto are substantively identical.

Because the present Office Action raises issues that could have been raised in the first Office Action on the merits, and entry of an Amendment After Final is discretionary with the Examiner, applicant may be denied the opportunity to address these issues.

In light of the above remarks, reconsideration of the finality of the Office Action is respectfully requested.

* * *

Respectfully submitted,
HELLER EHRMAN WHITE & McAULIFFE LLP

By:


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